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EXAMINER	
LEFF, STEVEN N	

ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
09/14/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary	Application No.	Applicant(s)	
	10/761,616	HU ET AL.	
	Examiner	Art Unit	
	STEVEN LEFF	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 June 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,8 and 10-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5, 8 and 10-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/25/09 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claims 1-5, 8 and 10-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
    - With respect to claim 1 the phrase "wherein the filler has water absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%" is rejected as it is unclear what the desired 200% absorbency of the package is relative too, i.e. relative to a package without any filler, a package of different volumes of a single filler, a package of different volumes of different fillers or if the desired absorbency due to the volume provided of a filler, due to the specific type of filler and/or due to the grain size of the filler. The phrase is further rejected due to the fact that an "absorbency rate" is with respect to a time, and thus the phrase is phrase "wherein the filler has water absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%" is further rejected since there is no defined time frame with respect to the absorbency rate.
    - The phrase "wherein the filler has water absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%" is further rejected since it is unclear if the water absorbency rate of the package is with respect to prior to the package prior to the soluble material absorbing water, during the soluble material absorbing water, or after all of the soluble material has passed through the package.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 1-5, 8, 10-16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Stipp (5554400).

Stipp teaches a beverage portioned package and a method for making a beverage portioned package (title) for preparing a beverage in an extraction device (col. 8 lines 30-35) in which the package is held between a water supplying part and a receiver of the device (col. 8 lines 30-35). More specifically Stipp teaches with respect to claim 1 a first surface for receiving water and allowing the water to flow into and through the package (col. 8 lines 14-29, col. 7 lines 63-65) under pressure when the package is operatively associated with the extraction device to form the beverage (col. 8 lines 30-35), a second surface that allows for the beverage to flow there through so that the beverage can be collected in the receiver of the device (col. 8 lines 14-29, col. 7 lines 63-65), where it is noted that Stipp teaches a sheet folded over and attached along three sides. In addition, the package contains a water-soluble beverage material in an amount sufficient to form the beverage (col. 9 lines 24-27, col. 11 line 37) and a filler comprising a water insoluble material (col. 3 lines 30-60) adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material (col. 9 lines 32-37), and that the ratio of water-soluble material to filler is between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (col. 9 lines 24-28, col. 9 lines 10-12, col. 11 lines 36-37) thus providing a filler which has water absorbent properties that are sufficient to provide a water absorbency rate of the package of at least 200%.

It is noted that Stipp teaches a filler which, as is claimed by applicant, in a preferred embodiment is specifically ground coffee (col. 3 lines 23-60). It is further noted that column 9 lines 24-28, col. 9 lines 10-12 of Stipp teaches that the water-soluble material comprises ground coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage, that the ratio of water-soluble material to filler is between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (col. 9 lines 24-28, col. 9 lines 10-12, col. 11 lines 36-37) and that the water-soluble material includes soluble coffee powder, milk powder, a creamer substitute powder or mixtures thereof (col. 9 lines 25-26, col. 4 lines 1-60). Therefore since it would be expected that the filler, which is ground coffee, as is claimed and taught by Stipp would provide the same naturally properties, and more specifically since Stipp does teach the same referenced materials, at applicant's desired ratio by volume, Stipp is taken to positively teach that the filler has water absorbent properties that are sufficient to provide a package having absorbency rate of at least 200%, and that the filler is present in an amount sufficient to form a pressure resistance bed (col. 9 lines 32-37).

Stipp continues by teaching with respect to claims 2-4 that the filler is present in an amount sufficient to form a pressure resistance bed (col. 9 lines 32-37), that the pressure resistance bed extends through the entire package (col. 15 lines 18-21), and that the pressure resistance bed comprises discrete pieces of the filler in the form of particulates, granules, flakes, fibers or combinations thereof (col. 9 lines 7-10, col. 3 lines 30-60). Stipp further teaches that the pressure resistance bed comprises at least one continuous porous piece in the form of a compacted piece (col. 8 lines 31-63), that the filler comprises a water-absorbent material which includes fresh ground coffee, spent ground coffee or a combination thereof (col. 3 lines 23-60), that the water-soluble material comprises coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage (col. 9 lines 24-28, col. 9 lines 10-12) and that the water-soluble material includes soluble coffee powder, milk powder, a creamer substitute powder or mixtures thereof (col. 9 lines 25-26, col. 4 lines 1-60).

Stipp further teaches a soluble or water extractable substance for aromatizing or flavoring the beverage (col. 5 lines 21-42), where the soluble or extractable substance is an aroma, coffee, an artificial flavor or a natural flavor (col. 5 lines 21-42), that the first

and second surfaces are walls made of a water-permeable material (col. 8 lines 25-31), and specifically filter paper sheets (col. 8 line 54) or plastic (col. 7 line 67) which has semi-solid walls which are pre-opened (col. 7 line 65). In addition, Stipp teaches the addition of a foaming creamer (col. 14 lines 59-60) yielding a beverage having a high foamed head (col. 15 line 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

- Claims 1-4, 8 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cai (20030096038) in view of Groen (EP1142483).

Cai teaches a method for making coffee, espresso, hot chocolate, mocha, latte or the like using a pod. "The pod contains first and second flavor-containing materials which are intended to be different materials to make blended drinks such as latte, cappuccino, mocha, milk-containing coffee and flavored espresso or coffee drinks. For example, when the first flavor-containing materials is the amount of milk particles required for making latte and the second flavor-containing materials is espresso coffee

grounds, latte will be made from the pod (col. 9 lines 61-64, col. 10 lines 1-5). It is noted that latte includes foam.

Cai further teaches a method for using the pod to make coffee, espresso, hot chocolate, mocha, latte or the like. The method comprises placing the pod(s) into a pod holder, forming a seal between the side wall and/or sealing seam of the pod(s) and the substantially vertical side wall of the pod holder when the pod is placed into the pod holder and the sealing seam is positioned inside the substantially vertical side wall of the pod holder (col. 6 lines 47-65), mounting the pod holder to a beverage apparatus, (col. 10 line 52-54) introducing hot water to the pod and forcing the water through the flavor-containing materials to extract or dissolve the flavor-containing materials to form fluid comestible, and discharging the fluid comestible into a receptacle such as a cup (col. 11 lines 1-10) through the filter paper (col. 5 line 26) or plastic body thereof (col. 5 line 47).

Cai further teaches the addition of a solubility promoter such that the water preferably passes through the numerous openings of the solubility promoter and becomes uniformly distributed onto the solids rather than through channels thus providing proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032).

However Cai is silent with respect to teaching the pod comprising a filler where the filler is specifically a water insoluble material and water absorbent material, wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties.

Groen teaches a coffee package (title). More specifically Groen teaches the addition of a water insoluble, water absorbent material in the coffee package that can be easily mixed with ground coffee (par. 0007). Groen continues by teaching that the filler may be filtering paper, or cellulose fiber as a few examples (par. 0007), for absorbing water (par. 0010, ex. 2 and 3).

Therefore since the specific type of filler, the volume of filler, the size of the package and other unclaimed variables would affect the desired rate of absorbency of the package, one of ordinary skill in the art would have been motivated to have combine the teachings and taught providing a specific filler wherein the ratio of filler to water-soluble

material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties since Cai teaches an infusion package comprising a soluble material and a filler and since Groen specifically teaches the use of a water insoluble, water absorbent material in the coffee package that can be easily mixed with ground coffee (par. 0007), as opposed to being separated therefrom for promoting proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032), as is desired by Cai.

Therefore since both Cai and Groen recognize the desire to provide an agent which absorbs water for its art recognized and applicant's intended purpose of promoting proper dissolution of the solids (par. 0027), in addition to the pod further comprising a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032), and since Groen specifically teaches, in one instance, applicant's desired filler material (par. 0007)it would have been obvious to one of ordinary skill in the art to teach a specific desired absorbency rate of the filler with respect to a package since all the claimed elements were known in the prior art and one skilled in the art could have substituted the optimum or workable ranges with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention.

Further since the claim is silent with respect to a volume provided of a filler, the specific type of filler and/or grain size of the filler, one of ordinary skill in the art would not expect the method of the instant claims to perform differently than the prior art methods, thus the claimed method is not patentably distinct from the prior art method (See MPEP 2144.04 IV A). "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation," (see MPEP 2144.05 IIA), as the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages" (see MPEP 2144.05 IIA) such that the water preferably passes through the numerous openings of the solubility promoter and becomes uniformly distributed onto the solids rather than through channels thus providing proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a

drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032) as is taught by Cai.

Therefore it would have been obvious to one of ordinary skill in the art to teach the pod comprising a filler where the filler is specifically a water insoluble material and water absorbent material, wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties since all the claimed elements were known in the prior art and one skilled in the art could have substituted the optimum or workable ranges with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention. It would have further been obvious since combining the two methods, each of which is taught by the prior art to be useful for the same purpose of providing a beverage from an infusible substance, flows logically from their having been individually taught in the prior art (see MPEP 2144.06), and since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination.

- Claims 1-3, 5 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cai 20030096038 in view of Schmidt (3833740).

Cai teaches a method for making coffee, espresso, hot chocolate, mocha, latte or the like using a pod. "The pod contains first and second flavor-containing materials which are intended to be different materials to make blended drinks such as latte, cappuccino, mocha, milk-containing coffee and flavored espresso or coffee drinks. For example, when the first flavor-containing materials is the amount of milk particles required for making latte and the second flavor-containing materials is espresso coffee grounds, latte will be made from the pod (col. 9 lines 61-64, col. 10 lines 1-5). It is noted that latte includes foam.

Cai further teaches a method for using the pod to make coffee, espresso, hot chocolate, mocha, latte or the like. The method comprises placing the pod(s) into a pod holder, forming a seal between the side wall and/or sealing seam of the pod(s) and the substantially vertical side wall of the pod holder when the pod is placed into the pod holder and the sealing seam is positioned inside the substantially vertical side wall of the pod holder (col. 6 lines 47-65), mounting the pod holder to a beverage apparatus, (col. 10

line 52-54) introducing hot water to the pod and forcing the water through the flavor-containing materials to extract or dissolve the flavor-containing materials to form fluid comestible, and discharging the fluid comestible into a receptacle such as a cup (col. 11 lines 1-10) through the filter paper (col. 5 line 26) or plastic body thereof (col. 5 line 47).

Cai further teaches the addition of a solubility promoter such that the water preferably passes through the numerous openings of the solubility promoter and becomes uniformly distributed onto the solids rather than through channels thus providing proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032).

However Cai is silent with respect to teaching the pod comprising a filler where the filler is specifically a water insoluble material and water absorbent material, wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties.

Schmidt teaches a coffee package (title). More specifically Schmidt teaches the addition of a water insoluble, water absorbent material in the coffee package that can be easily mixed with ground coffee, such as a porous sponge like body which has no smell or taste for facilitating thorough wetting and more rapid and thorough extraction of roasted coffee (col. 3 lines 45-57)

Therefore since the specific type of filler, the volume of filler, the size of the package and other unclaimed variables would affect the desired rate of absorbency of the package, one of ordinary skill in the art would have been motivated to have combine the teachings and taught providing a specific filler wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the fillers water absorbent properties since Cai teaches an infusion package comprising a soluble material and a filler and since Schmidt specifically teaches the use of a water insoluble, water absorbent material in the coffee package that can be easily mixed with ground coffee (col. 3 lines 45-54), as opposed to being separated therefrom for promoting proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make

the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032), as is desired by Cai.

Therefore since both Cai and Schmidt recognize the desire to provide an agent which absorbs water for its art recognized and applicant's intended purpose of promoting proper dissolution of the solids (par. 0027), in addition to the pod further comprising a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032), and since Schmidt specifically teaches, with respect to claim 5, applicant's desired filler material (par. 0007, it would have been obvious to one of ordinary skill in the art to teach a specific desired absorbency rate of the filler with respect to a package since all the claimed elements were known in the prior art and one skilled in the art could have substituted the optimum or workable ranges with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention.

Further since the claim is silent with respect to a volume provided of a filler, the specific type of filler and/or grain size of the filler, one of ordinary skill in the art would not expect the method of the instant claims to perform differently than the prior art methods, thus the claimed method is not patentably distinct from the prior art method (See MPEP 2144.04 IV A). "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation," (see MPEP 2144.05 IIA), as the normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages" (see MPEP 2144.05 IIA) such that the water preferably passes through the numerous openings of the solubility promoter and becomes uniformly distributed onto the solids rather than through channels thus providing proper dissolution of the solids (par. 0027), in addition to teaching the desire to provide a pod which further comprises a drying material "to make the used cartridge drip-free for mess-free disposal of the used cartridge (par. 0032) as is taught by Cai.

Therefore it would have been obvious to one of ordinary skill in the art to teach the pod comprising a filler where the filler is specifically a water insoluble material and water absorbent material, wherein the ratio of filler to water-soluble material is 1:1 and 1:8 by volume such that water absorbency rate of the package is at least 200% due to the

fillers water absorbent properties since all the claimed elements were known in the prior art and one skilled in the art could have substituted the optimum or workable ranges with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention. It would have further been obvious since combining the two methods, each of which is taught by the prior art to be useful for the same purpose of providing a beverage from an infusible substance, flows logically from their having been individually taught in the prior art (see MPEP 2144.06), and since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination.

- Claims 1-8, 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kane (2110732) in view of Cai (6777007).

  Kane teaches a beverage portioned package and a method for making a beverage portioned package (pg. 1 col. 2 lines 26-35) for preparing a beverage in an extraction device in which the package is held between a water supplying part and a receiver of the device (pg. 2 col. 2 lines 11-17) where it is noted that the water supplying part is interpreted as the water being poured and the cup is interpreted as the receiver where the package is on the receiver.

  More specifically Kane teaches with respect to claim 1 a bag or sack for receiving water and allowing the water to flow into and through the package (pg. 1 col. 2 line 37) under pressure when the package is operatively associated with the extraction device to form the beverage (pg. 1 col. 2 line 37), that allows for the beverage to flow there through so that the beverage can be collected in the receiver of the device (pg. 1 col. 2 lines 63-65), where the package contains a water-soluble beverage material in an amount sufficient to form the beverage (pg. 2 col. 2 lines 11-17), a filler comprising a water insoluble material (pg. 1 col. 1 lines 25-35) adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material (pg. 2 col. 1 lines 35-45, pg. 2 col. 2 lines 30-35), and that the ratio of water-soluble material to filler is between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (pg. 2 col. 2 lines 34-38).

It is noted that Kane teaches a filler which, as is claimed by applicant, is specifically "freshly roasted coffee" (pg. 2 col. 1 line 17). It is further noted that the water-soluble material comprises coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage (pg. 3 col. 2 lines 34-38) that the ratio of water-soluble material to filler is between 1:1 and 1:8 and more specifically 1:1 and 1:6 by volume (pg. 2 col. 2 lines 34-38) and that the water-soluble material includes soluble coffee powder (pg. 3 col. 1 lines 54-56).

Therefore since it would be expected that the filler, which is fresh ground coffee, as is claimed and taught by Kane would provide the same naturally properties, and more specifically since Kane does teach the same referenced materials, at applicant's desired ratio by volume, Kane is taken to positively teach that the filler has water absorbent properties that are sufficient to provide a package having absorbency rate of at least 200%, and that the filler is present in an amount sufficient to form a pressure resistance bed (col. 9 lines 32-37).

Kane continues by teaching with respect to claims 2-4 that the filler is present in an amount sufficient to form a pressure resistance bed (pg. 2 col. 2 lines 35-45), that the pressure resistance bed extends through the entire package (pg. 1 col. 2 lines 18-20), and that the pressure resistance bed comprises discrete pieces of the filler in the form of particulates, granules, flakes, fibers or combinations thereof (pg. 2 col. 1 lines 17-33). Kane further teaches that the filler comprises a water-absorbent material which includes fresh ground coffee, spent ground coffee or a combination thereof (pg. 2 col. 1 lines 18-32), that the water-soluble material comprises coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage (pg. 3 col. 2 lines 34-38) and that the water-soluble material includes soluble coffee powder (pg. 3 col. 1 lines 54-56).

Kane further teaches that the filler contains a soluble or water extractable substance for aromatizing or flavoring the beverage (pg. 1 col. 2 lines 31-35), where the soluble or extractable substance is an aroma, coffee, an artificial flavor or a natural flavor (pg. 1 col. 2 lines 31-35), that the first and second surfaces are walls made of a water-permeable material (pg. 1 col. 2 lines 37-39), which has semi-solid walls which are pre-opened (pg. 1 col. 2 lines 31-35).

However Kane is silent with regard to specifically stating that the bag or sack comprises a first surface for receiving water and allowing the water to flow into and through the package and a second surface that allows for the beverage to flow there through so that the beverage can be collected in the receiver of the device, in addition to being silent with respect to the pressure resistant bed comprising at least one continuous porous piece in the form of a web, a mat, a compacted piece, a foam or a combination thereof, that the first and second surfaces being disk-shaped sheets, a sealing seam for interconnecting the filter paper, and processing the package in an extraction device thus facilitating the formation of a foam on the beverage where the material is filter paper or plastic.

Cai teaches a method for making coffee, espresso, hot chocolate, mocha, latte or the like using a pod. "The pod contains first and second flavor-containing materials which are intended to be different materials to make blended drinks such as latte, cappuccino, mocha, milk-containing coffee and flavored espresso or coffee drinks. For example, when the first flavor-containing materials is the amount of milk particles required for making latte and the second flavor-containing materials is espresso coffee grounds, latte will be made from the pod (col. 9 lines 61-64, col. 10 lines 1-5). It is noted that latte includes foam.

Cai further teaches a method for using the pod to make coffee, espresso, hot chocolate, mocha, latte or the like. The method comprises placing the pod(s) into a pod holder, forming a seal between the side wall and/or sealing seam of the pod(s) and the substantially vertical side wall of the pod holder when the pod is placed into the pod holder and the sealing seam is positioned inside the substantially vertical side wall of the pod holder (col. 6 lines 47-65), mounting the pod holder to a beverage apparatus, (col. 10 line 52-54) introducing hot water to the pod and forcing the water through the flavor-containing materials to extract or dissolve the flavor-containing materials to form fluid comestible, and discharging the fluid comestible into a receptacle such as a cup (col. 11 lines 1-10) through the filter paper (col. 5 line 26) or plastic body thereof (col. 5 line 47).

Therefore, although Kane does not teach the placement of the beverage package within an extraction device where the resultant beverage contains foam due to the pressure of the water being introduced into the package, Kane does teach all of the limitations with regard to the beverage portioned package, in addition to teaching pouring

water over the package while in a receiver (pg. 2 col. 2 lines 15-16) where Cai teaches the desire to provide a seam which can be long enough to function as a handle (col. 6 lines 20-22) and thus one of ordinary skill in the art would have been motivated to combine the teaching of Kane and Cai since providing an automatic or mechanical means to replace a manual activity, which accomplishes the same result, is not sufficient to distinguish over the prior art (see MPEP 2144.04III).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have made or produced a beverage package containing both soluble and insoluble materials that is placed in an extraction device to produce a foamy beverage in order to more accurately control the amount of liquid, the strength and to provide a more timely manner of obtaining a coffee drink as is desired by Cai (col. 2 lines 55-63).

Further although Kane is silent with respect to the specific shape of the package or that the package is specifically filter paper or plasitc, Kane does teach a bag manufactured from water permeable paper and thus one skilled in the art could have used specifically a disc shaped filter paper with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention. Therefore, since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination it would have been obvious to one of ordinary skill in the art to teach a specific shape or a specific type of material which allows the product to diffuse there through as is desired by Kane, which is specifically disc shaped since Cai specifically teaches the sealing seam being long enough to function as a handle for the pod (col. 6 lines 20-22) in addition to teaching that the pod can adopt various shapes and materials (col. 5 lines 45-48) in addition to specifically teaching a disc shape (col. 6 line 38, fig. 4).

With respect to Kane being silent that the pressure resistant bed comprising at least one continuous porous piece in the form of a web, a mat, a compacted piece, a foam or a combination thereof, Kane does desire to provide a pressure resistant bed (pg. 2 col. 2 lines 35-45) and thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Kane and Cai and produce a beverage package containing soluble and insoluble materials that is used in an extraction device to make a foamy coffee beverage further comprising at least one continuous porous piece in the form of a

web, a mat, a compacted piece, a foam or a combination thereof in order to provide a package for use with an extraction machine for its art recognized and applicant's intended purpose of the providing a beverage pod that is sufficiently dried and drip-free right after preparing the beverage (col. 2 lines 65-68) thereby increasing its appeal to the consumer due to the cleanliness thereof making the product more desirable due to this advantage (col. 2 lines 57-68).

- Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stipp (5554400).

  With respect to claim 17 Stipp is silent with respect to the first and second surfaces being disk-shaped sheets.

  However Stipp teaches first and second surfaces manufactured from filter paper and interconnected adjacent their peripheral edges, with the interconnected parts of the sheets forming an annular sealing seam to allow the package to be held in the extraction device (col. 8 lines 25-35) and thus one skilled in the art could have used specifically a disc shaped filter paper with no change in their respective functions, thus yielding predictable results to one of ordinary skill in the art at the time of the invention. Therefore, since MPEP 2144.07 states that the selection of a known process based on its suitability for its intended use supports a prima facie obviousness determination and thus it would have been obvious to one of ordinary skill in the art to teach a specific shape, specifically disc shaped since Stipp specifically teaches adapting the "shape and design" of the bag with respect to the specific brewing method (col. 8 lines 33-35).

Response to Arguments

With respect to applicants argument that Stipp does not teach specific aspects of applicants invention, applicant is urged to column 3 lines 30-60 which teaches that the package contains a filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material (col. 9 lines 32-37), and that the filler comprises a water-absorbent material which includes fresh ground coffee, spent ground coffee or a combination thereof (col. 3 lines 23-60). Applicant if further urged to col. 9 lines 24-28, col. 9 lines 10-12 which teaches that the water-soluble material comprises coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids

in the final beverage and that the water-soluble material includes soluble coffee powder, milk powder, a creamer substitute powder or mixtures thereof (col. 9 lines 25-26, col. 4 lines 1-60). Therefore although applicant states that Stipp does not teach applicants specific water absorbancy rate, as was previously noted, although Stipp does not specifically state a percentage of absorbency rate for the package, Stipp does teach the same referenced materials at applicants desired ratio by volume. Therefore since it would be expected that the filler, which is ground coffee, as is claimed and taught by Stipp would provide the same naturally properties, and more specifically since Stipp does teach the same referenced materials, at applicant's desired ratio by volume, Stipp is taken to positively teach that the filler has water absorbent properties that are sufficient to provide a package having absorbency rate of at least 200%, and that the filler is present in an amount sufficient to form a pressure resistance bed (col. 9 lines 32-37).

It is further noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding Stipp not teaching applicants intended water absorbancy, in light of Stipp specifically teaching the same referenced materials at applicants desired ratio by volume, must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001".

In response to applicant's arguments against Kane and Cai individually it is noted that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case Kane is silent with regard to specifically stating that the bag or sack comprises a first surface for receiving water and allowing the water to flow into and through the package and a second surface that allows for the beverage to flow there through so that the beverage can be collected in the receiver of the device, in addition to being silent with respect to the pressure resistant bed comprising at least one continuous porous piece in the form of a web, a mat, a compacted piece, a foam or a combination thereof, that the first and second surfaces being disk-shaped sheets, a sealing seam for interconnecting the filter paper, and processing the package in an extraction device thus facilitating the formation of a foam on the beverage where the material is filter paper or plastic. However Cai teaches a method for making coffee, espresso, hot chocolate, mocha, latte or the like using a pod. "The pod contains first and second flavor-containing materials which are intended to be different materials to make blended drinks such as latte, cappuccino, mocha, milk-containing coffee and flavored espresso or coffee drinks. For example, when the first flavor-containing materials is the amount

of milk particles required for making latte and the second flavor-containing materials is espresso coffee grounds, latte will be made from the pod (col. 9 lines 61-64, col. 10 lines 1-5). It is noted that latte includes foam.

Cai further teaches a method for using the pod to make coffee, espresso, hot chocolate, mocha, latte or the like. The method comprises placing the pod(s) into a pod holder, forming a seal between the side wall and/or sealing seam of the pod(s) and the substantially vertical side wall of the pod holder when the pod is placed into the pod holder and the sealing seam is positioned inside the substantially vertical side wall of the pod holder (col. 6 lines 47-65), mounting the pod holder to a beverage apparatus, (col. 10 line 52-54) introducing hot water to the pod and forcing the water through the flavor-containing materials to extract or dissolve the flavor-containing materials to form fluid comestible, and discharging the fluid comestible into a receptacle such as a cup (col. 11 lines 1-10) through the filter paper (col. 5 line 26) or plastic body thereof (col. 5 line 47).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that Stipp and Kane avoid compaction to maintain the desired pressure during extraction) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Leff whose telephone number is (571) 272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Drew E Becker/
Primary Examiner, Art Unit 1794

/Steven Leff/
Examiner, Art Unit 1794